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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/520,824 | 01/07/2005 | Hirohisa Tanaka | 71465.00008 | 2715 |
| 57362 | 7590 | 05/10/2006 | EXAMINER | |
| AKERMAN SENTERFITT 801 PENNSYLVANIA AVENUE N.W. SUITE 600 WASHINGTON, DC 20004 | | | NGUYEN, CAM N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1754 | |

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/520,824

Applicant(s)

TANAKA ET AL.

Examiner

Cam N. Nguyen

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/27/06 (an amendment/response).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/31/06 & 3/09/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' amendment and remarks, filed February 27, 2006, has been made of record and entered. Claims 1 & 5 have been amended.

Claims 1-5 are currently pending and under consideration.

Claim Rejections - 35 USC § 102(e)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaneko et al., "hereinafter Kaneko", (US Pat. 6,800,388 B2).

Kaneko discloses a catalyst composition, which comprises: a perovskite composite oxide having the formula ABO_3 and the formula $A'_{1-x}A''_xB'_{1-y}B''_yO_3$, wherein A' is La, Ce or both, A' is at least one element selected from the group consisting of La, Ca, Sm, Ce, Sr, Ba and Pr, B' is at least one element selected from the group consisting of Co, Fe, Mn and Gd, and B'' is at least one element of noble metals, etc. (see col. 18, claim 1). See also Table 3 in col. 15 & 16.

There is no patentable distinction seen between the claimed catalyst and that disclosed by Kaneko, thus the claims are anticipated.

Claim Rejections - 35 USC § 102(b)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Monceux et al., "hereinafter Monceux", (US Pat. 5,62,680).

Monceux discloses a catalyst containing an active phase of the perovskite-type structure having the general formula: $L_x L'_{1-x} M_y M'_z \Phi_{1-y-z} O_3$, wherein L is an element selected from the lanthanides and the rare earth metals, L' is an element selected from Sr, Ca, Ba, Ce, K, Bi, Rb and Na, M is a transition metal selected from Cr, Mn, Fe, Co, Ni and Cu, M' is at least one metal selected from Pt, Ru, Pd, Rh, etc. (see col. 1, ln 40-57). See also Table II in col. 4, catalyst 9.

There is no patentable distinction seen between the claimed catalyst and that disclosed by Monceux, thus the claims are anticipated.

Response to Applicants' Arguments

6. Applicants' response, filed on February 27, 2006, to the office action dated 10/25/06 has been considered, but not deemed persuasive for the following reasons.

First, applicants urged, that “the catalyst composition of Kaneko, having a formula... which is directed to give different distortions in the perovskite structure than the claimed formula...” (applicants’ response on page 7, 1st paragraph). It is considered the disclosed catalyst composition having the same perovskite structure as being claimed since the metals are the same or the claimed metals are falling within the disclosed list of metals. The disclosed catalyst structure also contains the metals with valence of 3. While the Kaneko reference might not exemplified all of the listed metals in the examples of the reference, it is considered other metals that are not shown in the examples that are listed in the reference are also suitable and within the scope of the disclosed invention.

In response to applicants’ argument regarding the statement on “picking and choosing the particular elements to achieve the particular purpose of the present invention” (applicants’ response on page 8, 1st and 2nd paragraphs), in view of In re Schaumann, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), the claim is anticipated when the reference teaches a small genus which places a claimed species in the possession of the public and the species would have been obvious even if the genus were not sufficiently small to justify a rejection under 35 USC 102. See also MPEP 2131.02 and 2144.08. Since the metals with the valence of 3 are among the suitable metals listed in the reference, one of ordinary skill in the art at the time the invention was made would at once envisage the metals with valence of 3 within the listed metals of the reference.

With respect to applicants’ arguments regarding the Monceux reference, it is considered Monceux teaches a catalyst composition having the same structure as being

claimed since the metals are the same or the claimed metals are falling within the disclosed list of metals. The noble metal or Pt metal is contained in both catalyst compositions of the Kaneko and Monceaux references.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Claims 1-5 are pending. Claims 1-5 are rejected. No claims are allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 9:00 AM - 6:30 PM.

Application/Control Number: 10/520,824
Art Unit: 1754

Page 6

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn *CNN*
May 05, 2006

Cam Nguyen
CAM N. NGUYEN
PRIMARY EXAMINER

Art Unit - 1754